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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte

MARKUS GEWEHR, INGO ROSE, BERND MULLER, EBERHARD
AMMERMANN, ANN ORTH, and HENRY VAN TUYL COTTER

Appeal 2008-4449
Application 10/616,950
Technology Center 1600

Decided: September 29, 2008

Before, TONI R. SCHEINER, DEMETRA J. MILLS, and
RICHARD M. LEBOVITZ, *Administrative Patent Judges*.

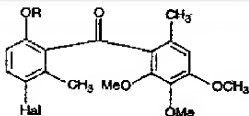
MILLS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134. The Examiner has rejected the claims for obviousness-type double patenting. We have jurisdiction under 35 U.S.C. § 6(b).

The following claim is representative.

1. A method for controlling *Pseudocercospora herpotrichoides* in crop plants comprising applying to said crop plants an effective amount of benzophenones of the formula I



in which

R is C₁-C₄-alkyl and

Hal is fluorine, chlorine or bromine.

Cited Reference

Sieverding (*497)

US 6,696,497 B2

Feb. 24, 2004

Grounds of Rejection

1. Claims 1, 2, 4 and 5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,696,497 to Sieverding.

DISCUSSION

Background

The present invention relates to a method for controlling *Pseudocercospora herpotrichoides* in crop plants comprising applying to said crop plants an effective amount of a specific benzophenone, as claimed. (Spec. 1.)

The Examiner contends that

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the US '297 [sic. '497] are considered obvious since the term "comprising" is used in the instant invention.

The term "comprising" allows other additional components to be added. Instant claims are obvious because compound of formula (1) in claim 1 contains the same substituents.

Claim 1 of present application overlaps claim 1 of US '497 because at 5-position of benzophenone ring contain halogen wherein US '497 it is bromine (Br). Claims 2 and 4 of the present invention is same as in claim 1 of compound (a) of US '497. Method claimed in claim 1, 2, 4 and 5 for controlling *Pseudocercospora herpotrichoides* in wheat and barley overlaps with the method of claim 4 and 5 of US Patent '497.

The patent claims composition and method of controlling fungi by using 5-bromo 6-dimethyl-2,4',5',6'-tetramethoxy-benzophenone.

The instant claims differ from the claims of the cited US Patents in that US '497 claims specific second components for the fungicidal composition and method for controlling fungi. In the instant claims, a specific second ingredient has not been named. However, the term "comprising" allows a second ingredient to be added. The method of claim 4 is for "controlling growth of fungi" which includes *Pseudocercospora herpotrichoide*.

Therefore, the instant invention is considered obvious over the claims of the cited US Patent '497.

(Ans. 4-5.)

Appellants contend that

the Examiner's argument is deemed to be erroneous in that it fails to appreciate appellants' requirement that "*effective amounts of benzophenones of the formula I*" be employed in the method. Appellants' respective requirement cannot reasonably be considered as being synonymous with the requirement of Sieverding et al. for "*synergistically effective amounts of ... a benzophenone ... and a valinamide ...*"

(App. Br. 8).

We find no error with the Examiner's *prima facie* case of obviousness-type double patenting. To determine if obviousness-type double-patenting is present one must determine if any claim in the application at issue defines merely an obvious variation of an invention disclosed and claimed in the cited patent. *In re Vogel*, 422 F.2d 438, 441-42 (CCPA 1970).

"[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Thus, in obviousness-type double patenting rejections, the Examiner must establish, in an analysis comparable to that under 35 U.S.C. § 103, that one of ordinary skill would have considered the rejected claims obvious over the conflicting claims. *See In re Braat*, 937 F.2d 589, 592-93 (Fed. Cir. 1991).

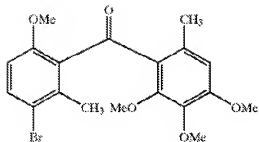
To show that a claimed invention is "a mere variation . . . which would have been obvious to those of ordinary skill in the relevant art . . .

there must be some clear evidence to establish why the variation would have been obvious...” *In re Kaplan*, 789 F.2d 1574, 1580 (Fed. Cir. 1986).

The disclosure of a reference patent may not be used as prior art; in certain situations, however, it may be used to define terms in claims and to determine whether an embodiment claimed was modified in an obvious manner. *Carman Indus., Inc. v. Wahl*, 724 F.2d 932, 940 (Fed. Cir. 1983).

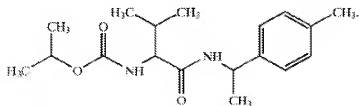
Claims 1 and 4 of the ‘497 Patent are reproduced below.

1. A fungicidal composition comprising a fungicidally acceptable carrier and/or surface active agent together with synergistically effective amounts of
(a) a benzophenone of the formula



and

- (b) a valinamid of the formula



4. A method of controlling the growth of fungi at a locus which comprises applying a compound as claimed in claim 1, to the locus.

We agree with the Examiner that the claims of the pending application contain the transitional phrase “comprising” and thus are open to additional claim elements. Thus the Examiner has established that the pending claims would have been obvious over the patented claims.

Appellants rely on two Declarations of R. Stierl dated June 6, 2005 and January 16, 2006, as evidence of non-obviousness of the claimed invention. (App. Br. 9.) We find that the Stierl Declaration of Jan. 16, 2006 provides sufficient evidence to overcome the Examiner’s prima facie case of obviousness-type double patenting. In particular, the Declaration provides evidence that one of ordinary skill in the art would not have expected a fungicide effective against a powdery mildew disease growing on top of leaves to be effective against a pathogenous fungus that grows in plant tissue, as claimed in the pending application. (Stierl Declaration 2006, p. 3.)

The Examiner fails to provide rebuttal argument to the Declaration of Stierl 2006.

In view of the above, the obviousness-type double patenting rejection is reversed.

SUMMARY

The obviousness-type double patenting rejection is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

REVERSED

Appeal 2008-4449
Application 10/616,950

cdc

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